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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,707	07/11/2000	Claudia Lanari	P02004US0	1059

26271 7590 12/18/2001
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EXAMINER

DAVIS, NATALIE A

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 12/18/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/613,707

Applicant(s)

LANARI ET AL.

Examiner

Natalie A. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-6,9 and 10 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-8 and 12 is/are allowed.
- 6) ☒ Claim(s) 5 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

The Group Art Unit and examiner of the application has been changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Dr. Natalie A. Davis Art, Unit 1642.**

Applicant's election without traverse of Group IV, claims 5-8 and 11-12 and amendments to claim 7-8 and 12 in Paper No. 8 is acknowledged.

The requirement is still deemed proper and is therefore made FINAL. Claims 5-8 and 11-12 are being examined as belonging to the elected Group IV, while claims 1-6 and 9-10 are withdrawn from examination as being drawn to a non-elected invention.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It does not identify the citizenship of each inventor.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification (p. 5) is rejected under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention and failing to provide an enabling disclosure, because the specification does not provide evidence that the claimed biological

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materials are (1) known and readily available to the public; (2) reproducible from a written description (e.g. sequenced); or (3) deposited.

It is unclear if the mouse mammary adenocarcinoma a cell line is known and publicly available, or can be reproducibly isolated without undue experimentation. Therefore, a suitable deposit for patent purposes is suggested. Without a publicly available deposit of the above cell line, one of ordinary skill in the art could not be assured of the ability to practice the invention as claimed. Exact replication of the claimed cell line is an unpredictable event. Therefore, it would require undue experimentation to reproduce the claimed cell line derived from murine progesterin independent C7HI tumor, wherein it expresses ER and PR. Deposit of the cell line would satisfy the enablement requirements of 35 U.S.C. § 112, first paragraph. See, 37 C.F.R. 1.801-1.809.

The instant application does not provide the appropriate evidence of satisfying the deposit of the cell line for the enforceable life of the patent. In addition to the conditions under the Budapest Treaty, applicant is required to satisfy that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent in U.S. patent applications. Applicant's provision of these assurances would obviate this objection/rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 5 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Dran, et al., (1995).

6. The claims are drawn to a mouse mammary adenocarcinoma a cell line that expresses estrogen and progesterone receptors. The claims are further drawn to a method for testing the activity of various agents on cell proliferation and a kit for determining the same.

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7. Dran, et al. set forth murine mammary adenocarcinoma cell lines with estrogen and progesterone receptors, derived from progestin-independent and progestin-dependent tumors (p. 174, col. 2). Dran, et al, further disclose a method of testing the activity of hormones and anti-hormones on the cell lines by quantifying cell proliferation using 3H-thymidine and/or autoradiography and immunocytochemistry. The kit of claim 11 is inherently disclosed as the method used in testing the activity of hormones and anti-hormones on the cell lines, comprise all of the components of the kit. Accordingly, Dran, et al. anticipate the invention as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Davis whose telephone number is 703-308-6410. The examiner can normally be reached on M-F 8-5:30 (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4315 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Natalie A. Davis, Ph.D.
December 12, 2001

